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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/607,843

06/30/2000

Kia Silverbrook

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01/27/2005

SILVERBROOK RESEARCH PTY LTD
393 DARLING STREET
BALMAIN, 2041
AUSTRALIA

EXAMINER

SUBRAMANIAN, NARAYANSWAMY

ART UNIT

PAPER NUMBER

3624

DATE MAILED: 01/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/607,843

Applicant(s)

SILVERBROOK ET AL.

Examiner

Narayanswamy Subramanian

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) 4-7 and 32-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,8-31 and 36-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/608022.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/7/2001.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is in response to Applicants communication dated August 13, 2004. Original claims 1-48 are pending. Applicants' provisional election to prosecute inventions I and IV comprising claims 1-3, 8-31 and 36-48 has been noted. Applicants' arguments for combining group I and IV for examination purposes is persuasive and hence the restriction between these two groups is withdrawn by the Examiner. Claims 4-7 and 32-35 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention. Applicants are respectfully advised to cancel the non-elected claims in response to this office action. Elected claims 1-3, 8-31 and 36-48 have been examined. The rejections are stated below.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter that the applicant regards as his invention.

3. Claims 29-31 and 36-48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. For claims 29-31 and 36-48, it is not clear if the term "A system" refers to "a method" or "an apparatus". Clarification is required.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3, 8-31 and 36-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patterson, Jr. et al (US Patent 5,797,002) in view of Richards et al (US Patent 6,539,361 B1).

With reference to Claims 1 and 29, Patterson discloses a method and system of enabling financial transaction, the method including the steps of: providing the user with a form containing information relating to a financial transaction, the form including coded data indicative of an identity of the form and of at least one reference point of the form; receiving, in a computer system, indicating data from a sensing device regarding the identity of the form and a position of the sensing device relative to the form, the sensing device, when placed in an operative position relative to the form, sensing the indicating data using at least some of the coded data; and identifying, in the computer system and from the indicating data, at least one parameter relating to the financial transaction (See Patterson Column 13 line 20 – Column 15 line 55)

Patterson does not explicitly disclose the step where the user is a banking customer and the financial transaction is an online banking transaction.

Richards discloses the step where the user is a banking customer and the financial transaction is an online banking transaction (See Richards Abstract, Column 1 lines 16-44, Column 2 line 67 – Column 3 line 54)

Both Patterson and Richards are concerned with providing means for conducting financial transactions. It would have been obvious to one with ordinary skill in the art at the time of invention to include the disclosures of Richards to the invention of Patterson. The

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combination of the disclosures taken as a whole suggests that online banking customers would have benefited from being able to use a form that makes banking easier.

With reference to Claims 2 and 30, Patterson discloses a method and system of claims 1 and 29 respectively, in which said at least one parameter relating to the financial transaction is associated with at least one zone of the form and in which the method includes identifying, in the computer system and from the zone relative to which the sensing device is located, said at least one parameter (See Patterson Column 13 lines 32-45).

With reference to Claims 3 and 31, Patterson discloses a method and system of claims 2 and 29 respectively, including receiving, in the computer system, data regarding movement of the sensing device relative to the form, the sensing device sensing its movement relative to the form using at least some of the coded data; and identifying, in the computer system and from said movement being at least partially within said at least one zone, said at least one parameter of the financial transaction (See Patterson Column 13 lines 32-45).

With reference to Claims 8 and 36, Patterson discloses a method and system of claims 2 and 29 respectively, in which the parameter is an action parameter of the financial transaction, the method including effecting, in the computer system, an operation in respect of the action parameter (See Patterson Column 13 lines 20-32).

With reference to Claims 9 and 39, Richards discloses the step where the action parameter includes a request for information relating to banking services, a request for a withdrawal of funds, a request for a transfer of funds, a request for an account balance, a payment of a bill (See Richards Column 1 lines 26-44)

With reference to Claim 10, Patterson discloses a method of claim 3, in which the parameter is an option parameter of the financial transaction, the method including identifying, in the computer system, that the user has entered a hand-drawn mark by means of the sensing device and effecting, in the computer system, an operation associated with the option parameter (See Patterson Figures 4, 8, 11 and Column 13 line 20 – Column 15 line 55).

With reference to Claims 11 and 38, Richards discloses a method and system of claims 10 and 36 respectively, in which the option parameter is associated with one of a request for information relating to banking services, an order for checks, a request to stop checks, an application for a new account, an application for a loan, a request for an account history, a request for a withdrawal of funds, a request for a transfer of funds, a request for an account balance, a payment of a bill, a request for a list of bill payments, an account, a currency, and a payee name (See Richards Column 1 lines 26-44).

With reference to Claims 12 and 13, Patterson discloses a method of claim 3, in which the parameter is a text parameter of the financial transaction, the method including identifying, in the computer system, that the user has entered handwritten text data by means of the sensing device and effecting, in the computer system, an operation associated with the text parameter including converting, in the computer system, the handwritten text data to computer text (See Patterson Figures 4, 8, 11 and Column 13 line 20 – Column 15 line 55).

With reference to Claims 14 and 39, the step where the text parameter is associated with at least one of a check amount, a payee name, a currency amount, a transfer amount, a payment amount, a payment date, and a check number is old and well known in the banking art. These steps allow a checking transaction to be identified.

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With reference to Claims 15 and 16, Patterson discloses a method of claim 3, in which the parameter is an authorization parameter of the financial transaction, the method including identifying, in the computer system, that the user has entered a handwritten signature by means of the sensing device and effecting, in the computer system, an operation associated with the authorization parameter including verifying, in the computer system, that the signature is that of the user (See Patterson Figures 4, 8, 11 and Column 13 line 20 – Column 15 line 55). The verifying step is inherent in the disclosure of Patterson.

With reference to Claims 17 and 40, Richards discloses a method and system of claims 16 and 36 respectively, in which the authorization parameter is associated with authorization for at least one of access to account information, withdrawal of funds, transfer of funds, payment of a bill, modification of a bill payment, deletion of a bill payment, stopping of checks, and ordering of checks (See Richards Column 1 lines 26-44 and Column 3 lines 1-54).

With reference to Claims 18, 19 and 41, Richards and Patterson combined disclose a method and system of claims 3 and 36 respectively, as discussed above.

Richards and Patterson combined do not explicitly teach the step in which the parameter is a picture parameter of the banking transaction, an operation associated with the picture parameter which in turn is associated with a design for customer's checks.

Official notice is taken that having a picture parameter of the banking transaction, an operation associated with the picture parameter, which in turn is associated with a design for customer's checks is old and well known in the art. These steps help in timely identification of the parameter and also minimize the text necessary to identify the item (A picture is sometimes worth a thousand words).

It would have been obvious to one with ordinary skill in the art at the time of invention to include these steps to the combined disclosures of Richards and Patterson. The combination of the disclosures taken as a whole suggests that users would have benefited from the ease in identifying the parameter of interest.

With reference to Claim 20, Richards discloses a method of claim 1, in which the form contains information relating to at least one of information relating to banking services, a request for an account history, a request for a withdrawal of funds, a request for a transfer of funds, a request for an account balance, and a payment of a bill (See Patterson Figures 4, 8, 11 and Column 13 line 20 – Column 16 line 55).

With reference to Claims 21- 23, 28, 44-46 and 48, Patterson discloses a method and system of claims 1 and 29 respectively, includes printing the form on demand and printing the form on a surface of a surface-defining means. (See Patterson Column 9 lines 30-40).

Richards and Patterson combined do not explicitly disclose printing the coded data on a surface, which is substantially invisible in the visible spectrum and printing on multiple pages and in which the method includes binding the pages.

Official notice is taken that printing the coded data on a surface, which is substantially invisible in the visible spectrum and printing on multiple pages and in which the method includes binding the pages is old and well known in the art. Printing coded data on a surface, which is substantially invisible in the visible spectrum enhances the security of the codes being printed and printing on multiple pages and binding them helps keep the records together.

It would have been obvious to one with ordinary skill in the art at the time of invention to include the step of printing the coded data on a surface, which is substantially invisible in the

visible spectrum to the combined disclosures of Richards and Patterson. The combination of the disclosures taken as a whole suggests that users would have benefited from the enhancement of security of the codes being printed and keeping the records together by printing on multiple pages and binding them.

With reference to Claims 24, 26, 47 and 43, Patterson discloses a method and system of claims 1 and 29 respectively, including retaining a retrievable record of each form generated, the form being retrievable using its identity as contained in its coded data (See Patterson Column 29 line 57 – Column 30 line 47) and in which the sensing device contains an identification means which imparts a unique identity to the sensing device and identifies it as being associated with a particular user and in which the method includes monitoring, in the computer system, said identity (See Patterson Column 13 line 20 – Column 16 line 55).

With reference to Claims 25 and 27, Patterson discloses a method of claim 1, including distributing a plurality of the forms using communications protocols (See Patterson Column 19 lines 11-27 and Column 23 lines 44-47) and including providing all required information relating to the financial transaction in the form to eliminate the need for a separate display device (See Patterson Figures 4, 8, 11 and Column 13 line 20 – Column 16 line 55). The communications protocols are interpreted to include a mixture of multicast and pointcast communications protocols.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is


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(703) 305-4878. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (703) 308-1065. The fax number for Formal or Official faxes and Draft or Informal faxes to the Patent Office is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

N. Subramanian
January 6, 2005


Jagdish N. Patel
Primary Examiner